

Application No. 09/761,636  
Reply to Office Action of October 14, 2004

Attorney Docket No.: 48505US

### REMARKS/ARGUMENTS

The advisory Office Action issued on May 10, 2005 refused to enter the claim amendments submitted by applicants on March 14, 2005. The advisory Office Action asserted that the amendment "raises new issues that would require further consideration and/or search" because the term "having" is open ended. Applicants respectfully disagree. The issue that the claims contain open ended transitional phrases is not a new one and has been the basis of numerous previous Office Actions rejecting the claims. Furthermore, the term "having" as used in the phrase "having a sequence [of SEQ ID NO:5...] with one or two amino acid residues deleted or inserted" is not open-ended. It specifically states that it cannot have an unlimited number of amino acid residues added at the end. This meaning is made very clear by applicants remarks submitted in the Reply (see first paragraph on page 14 of the Reply dated March 14, 2005).

In any event, applicants hereby submit a new claim amendment, replacing the term "having" with "consisting of" to eliminate this issue.

Furthermore, applicants have corrected a clerical error with regard to the amendment to Claim 53.

Accordingly, it is respectfully submitted that the amendment to the claims either place the claims in condition for allowance, or minimize issues for appeal, without raising any new issues for consideration or search. Entry of the claim amendments and favorable reconsideration are respectfully considered.

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As amended, Claim 1 recites that the claimed sequences comprise a cyclic core consisting of the specific sequences embodied in the listed sequences, or a corresponding sequence with one or two conservative substitutions or one or two insertions or one or two deletions, and that the claimed sequences have certain other structural and functional characteristics. Claim 49 has been amended to exclude SEQ ID NO: 5 and SEQ ID NO: 6, and claims 52 and 53 have been amended to recite that the claimed sequences consisting of SEQ ID NOs: 5 and 6.

Applicants respectfully submit that the amendments are fully supported by the application as originally filed. Entry of the amendments and favorable reconsideration of all claims are respectfully requested.

Claims 1-4, 12, 14-18, 23-26, 49-63, 72-103 are pending and under examination. Applicants gratefully acknowledge the indication that Claims 50, 54 and 55 are allowable.

#### **Finality of Office Action**

The advisory Office Action also refused to withdraw the finality of the final Office Action, and asserts the claim amendment of June 25, 2004 raises issues of new matter. Regardless of the merits of this assertion, it does not detract from the fact that the final Office Action contains new grounds of rejections to the claims not necessitated by any amendments to the claims. Specifically, Claims 49, 52 and 53 are newly rejected over prior art not previously of record, yet Claim 49 was never amended and the previous amendment to

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Claims 52 and 53 was not substantive. Accordingly, it is respectfully requested that the finality of the Office Action be withdrawn.

**Rejections under 35 U.S.C. §112 ¶ 1**

The final Office Action continues to base much of the reasoning of the lack of enablement and lack of written description rejections on the notion that "the term comprising is open-ended." In fact, this phrase is repeated at least nine (9) times in the final Office Action. However, even prior to the current claim amendments, the claimed core sequence is not open ended and consists of a well-defined sequence of very limited length.

The final Office Action also continues to assert that the "receptor binding loops" of VEGF-D are not defined. This is incorrect because, as made amply clear by Figures 1 and 6 and the accompanying description, the loops and their amino acid sequences are well defined. Figures 1 and 6 show the three loops and the determination of their amino acid sequences based on backbone tracing techniques.

In order to eliminate the examiner's concerns over the "comprising" language, applicants have amended Claim 1, to stress that the claimed core sequence consists of precisely defined sequences. Furthermore, in order to expedite prosecution, without acquiescing to the examiner's assertions, applicants have amended Claim 1 to recite the specific loop sequences described in the specification by their nucleotide sequences. As amended, the claims now recite loop sequences specifically, and sequences which have one or two

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conservative substitutions or insertions or deletions. Accordingly, applicants respectfully submit that these amendments address both concerns of the examiner and overcome the claim rejections under 35 U.S.C. § 112, and have overcome all claim rejections under 35 U.S.C. § 112, first paragraph (with the exception of the "new matter" rejection discussed below).

#### **"New Matter" Rejections**

The final Office Action rejected Claims 1-3, 23 and 72-87 for alleged containing impermissible "new matter." Specifically, the Office Action states that the recitation of "mimics a native conformation in the corresponding region of VEGF, VEGF-C" is new matter. Applicants respectfully traverse, and direct the examiner's attention to lines 10-14, page 30 of the specification, which states that the monomeric monocyclic peptides created "mimic the conformation of each of the native loops." Accordingly, it is respectfully submitted that the claim language is specifically supported by the specification and is not new matter.

#### **Claim Rejections under 35 U.S.C. §102**

The Office Action further rejected claims 49, 52 and 53 under 35 U.S.C. § 102 (e) or (b) over Yamada et al., Achen et al., or Le et al., arguing that these references inherently disclose a cyclic peptide because the peptides disclosed therein contains two cysteine residues in vicinity of each other, which will inherently link with each other to form a cyclic peptide. Applicants respectfully traverse. Although the a cysteine residue may form a disulphide link with another cysteine, there is no indication in the cited references that they will

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necessarily form a link with each other to form the presently claimed cyclic peptide.

In order to expedite prosecution, applicants have amended these claims, such that Claim 49 does not recite SEQ ID NO: 5 or 6, and claims 52 and 53 now recite a cyclic peptide consisting of SEQ ID NO: 5 or 6, respectively. Accordingly, these claim amendments have rendered the claim rejections under 35 U.S.C. § 102 moot.

#### Conclusion

Applicants respectfully submit that all claims are now in condition for allowance and solicit an early indication from the Examiner to this effect.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

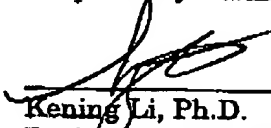
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If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #: 029065.48505US).

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Respectfully submitted,

  
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